

Remarks

This Application has been carefully reviewed in light of the Office Action dated February 17, 2004. Applicant appreciates the Examiner's consideration of the Application. Although Applicant believes all original claims are allowable over the prior art of record, Applicant amends Claims 1-8, and 10-36. Certain of these amendments have not narrowed the claims and none are considered necessary for patentability. Applicant cancels Claim 9. Applicant also submits new Claims 37-51. Applicant respectfully requests reconsideration and allowance of all pending claims.

Objection to the Drawings and Telephone Interview

Applicant appreciates the telephone interview with Examiner Rayyan on May 13, 2004, during which the Examiner and Applicant's representative, Charles Suh, reached an agreement that (1) the objection to the drawings should be withdrawn because the figures of the present application in fact show the claimed invention, and (2) no correction to the drawings is required.

Information Disclosure Statement

The Office Action states that articles identified on lines A and B of the "NON-PATENT DOCUMENTS" section of the PTO Form 1449 submitted July 17, 2003 have not been considered because paper copies of those articles have not been provided to the Examiner. Regardless of whether copies were previously provided, Applicant now provides copies of the articles with an accompanying PTO Form 1449 to advance the prosecution of this case. Applicant respectfully requests the Examiner to indicate consideration of the articles by initialing next to the articles on the PTO Form 1449.

The Claims are Allowable over *Ford* and *Spiegel*

The Examiner rejects Claims 1-9, 11-20, 22-31, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over *Ford* et al. (U.S. Patent Application Publication US 2003/0195877), hereinafter *Ford*, in view of *Spiegel* et al. (U.S. Patent 4,466,918 B1), hereinafter *Spiegel*. For reasons described above, the rejection of Claims 2-6, 8, 11, 13-17, 19-20, 22, 24-28, 30-31, and 33 are considered moot. Applicant respectfully submits that

independent Claims 1, 7, 12, 18, 23, 29, 34-36, and 37-51 and their dependent claims are allowable over the cited references for at least the reasons provided below.

**The Proposed Combination of References Fails to Meet
the Limitations Recited in Applicant's Claims**

Independent Claims 1, 12, 23, and 34-36

Independent Claim 1 is allowable over the proposed *Ford-Spiegel* combination at least because neither *Ford*, *Spiegel*, nor the proposed *Ford-Spiegel* combination discloses, teaches, or suggests a “buyer profile comprising *a record of the number of times each of a plurality of seller-oriented sort criteria* has appeared in at least some previous events involving the buyer, *each of the plurality of seller-oriented sort criteria in the buyer profile associated with at least one seller attribute*” and “accessing the buyer profile” to determine an order of display *based on the number of times one or more of the plurality of seller-oriented sort criteria* in the buyer profile applicable to the search results have appeared in the previous events involving the buyer,” as recited in Claim 1. *Ford* fails to disclose “a seller attribute,” as the Examiner concedes. (See Office Action, Page 5) Although *S piegel* discloses “purchase histories 272 [that] keep track of the products that have been purchased by the user and may . . . be in the form of lists of product identification numbers,” (emphasis added) *S piegel* fails to disclose, teach, or suggest the use of sort criteria and seller attributes as specifically recited in Claim 1. Thus, Claim 1 is allowable over the proposed *Ford-Spiegel* combination for at least this reason. For at least analogous reasons, independent Claims 12, 23, and 34-36 are also allowable. Applicant respectfully requests reconsideration and allowance of independent Claims 1, 12, 23, and 34-36, together with all their dependent claims.

Independent Claims 7, 18, and 29

The proposed *Ford-Spiegel* combination also fails to disclose, teach, or suggest each and every limitation specifically recited in independent Claims 7, 18, and 29.

At a minimum, as the Examiner implicitly acknowledges by her silence, *Ford* fails to disclose, teach, or suggest determining an “*order of display according to the number of*

times a leading attribute value for each of a plurality of attributes has appeared in events involving the buyer, a leading attribute value for an attribute being the attribute value appearing more often than any other attribute value for the attribute," as recited in Claim 7. (See Office Action, Page 6) Applicant respectfully disagrees that Column 6, lines 10-14 of *Spiegel* makes up for this deficiency.

The identified portion of *Spiegel* discloses collecting information about browsing and purchasing activities of users and using this information to automatically evaluate the popularity levels of specific item nodes and category nodes of a tree. The identified portion of *Spiegel* also discloses automatically elevating the display priority of nodes that are determined to be most popular. But *Spiegel* provides no disclosure, teaching, or suggestion of determining an "*order of display according to the number of times a leading attribute value for each of a plurality of attributes has appeared in events involving the buyer, a leading attribute value for an attribute being the attribute value appearing more often than any other attribute value for the attribute,"* as recited in Claim 7. Rather, the identified portion of *Spiegel* merely discloses displaying nodes based on their popularity.

For at least these reasons, Applicant respectfully submits that *Spiegel* is wholly inadequate to make up for the clear and acknowledged deficiency of *Ford*. And, for at least this reason, the proposed *Ford-Spiegel* combination fails to disclose, teach, or suggest determining an "*order of display according to the number of times a leading attribute value for each of a plurality of attributes has appeared in events involving the buyer, a leading attribute value for an attribute being the attribute value appearing more often than any other attribute value for the attribute,"* as recited in Claim 7. Thus, for at least this reason, Claim 7 is allowable over the proposed *Ford-Spiegel* combination. For at least analogous reasons, independent Claims 18 and 29 are also allowable. Applicant respectfully requests reconsideration and allowance of independent Claims 7, 18, and 29, together with all their dependent claims.

The Proposed Combination of References is Improper

Even assuming for the sake of argument that the *Ford-Spiegel* combination did disclose, teach, or suggest the limitations specifically recited in Applicant's claims, which Applicant disputes, the rejection of the claims would still be improper because the Examiner has not identified anything in *Ford*, *Spiegel*, or knowledge generally available to those of ordinary skill in the art at the time of the invention as providing the requisite teaching, suggestion, or motivation to combine *Ford* with *Spiegel* in the manner and for the reasons the Examiner proposes. The rejected claims are also allowable for at least this reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally

available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to demonstrate a motivation in the prior art to combine the references that are alleged to create the case of obviousness. See *id.* See also, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board, explaining again that the required evidence of such a teaching, suggestion, or motivation is absolutely essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

Applicant respectfully submits that the Examiner has not identified anything in *Ford*, *Spiegel*, or knowledge generally available to those of ordinary skill in the art at the time of the invention sufficient to teach, suggest, or motivate the proposed combination of a method for search query processing to provide category-ranked presentation of search results as disclosed in *Ford* with a method for exposing popular nodes within a browse tree as disclosed in *Spiegel*. Applicant respectfully submits that the Examiner's speculation that "it would have been obvious" at the time of the invention to combine the teachings of *Ford* with *Spiegel* to "provide an alternative method for evaluating popularity levels of specific books," in hindsight with the benefit of Applicant's claims as a roadmap for selecting portions of multiple references, is insufficient under the M.P.E.P. and governing Federal Circuit case law.

Acknowledged Allowable Subject Matter

Applicant appreciates the Examiner's acknowledgment that Claims 10, 21, and 32 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant rewrites Claims 10, 21, and 32 in independent form to include all the limitations of the base claim and any intervening claims. Dependent Claims 2-6, 8, and 11 have been amended to depend from allowable independent Claim 10. Claims 13-17, 19-20, and 22 have been amended to depend from allowable independent Claim 21. Claims 24-28, 30-31, and 33 have been amended to depend from allowable independent Claim 32. Applicant respectfully requests allowance of independent Claims 10, 21, and 32 and their dependent claims.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant attaches a check for \$768.00 for six additional independent claims and fourteen additional claims over twenty total. Although Applicant believes no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Christopher W. Kennerly
Reg. No. 40,675

Correspondence Address:

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Tel. (214) 953-6812

Date: May 28, 2004